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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

JEAN-MARIE STAWIKOWSKI, ET AL. : EXAMINER: CHANKONG, D.

SERIAL NO: 09/940,462 :

FILED: AUGUST 29, 2001 : GROUP ART UNIT: 2152

FOR: COMMUNICATION SYSTEM OF :
AN AUTOMATION EQUIPMENT BASED
ON THE SOAP PROTOCOL

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a reply to the Examiner's Answer dated July 5, 2006. This Reply Brief addresses the assertions made in the Examiner's Answer with respect to the original grounds of rejection.

I. REAL PARTY-IN-INTEREST

The real part-in-interest is Schneider Automation.

II. RELATED APPEALS AND INTERFERENCES

The status of related appeals and interferences is the same as provided in the Appeal Brief.

III. STATUS OF CLAIMS

Claims 1-20 have been finally rejected and form the basis for this appeal. Appendix VIII of the Appeal Brief includes a clean copy of appealed Claims 1-20.

IV. STATUS OF AMENDMENTS

No amendments after final rejection have been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1 is directed to a communication system including at least one processing unit capable of running a program to provide automation functions, and one or more remote devices running a computer program or group of computer programs. The communications system is based on the Simple Object Access Protocol (SOAP) for the purpose of providing the remote device with supervision, display, control, configuration or programming functions of the automation equipment. The communications system comprises, in the automation equipment, at least one WEB service or one WEB client which is capable of (1) interacting with the program of the automation equipment, (2) decoding messages received from the IP network encoded according to the SOAP protocol, and (3) encoding according to the SOAP protocol messages to be sent on the IP network. An exemplary embodiment is described in the specification from page 6, line 25 to page 7, line 21 with reference to Figure 1. In this exemplary embodiment, automation equipment 10 includes at least one processing unit capable of running a program 20 to provide automation functions. A remote device 30 runs a computer program 31. Automation equipment 10 includes at least one WEB service 21 or one WEB client 22 which is capable of (1) interacting with the program 20 of the automation equipment 10, (2) decoding messages

received from IP network 50 encoded according to the SOAP protocol, and (3) encoding according to the SOAP protocol messages to be sent on the IP network 50.

Independent Claim 18 is directed to a communication process including: running a computer application in a remote device, sending from an application a read request on an IP network in order to receive in a response a service description document, developing, manually or automatically, by means of the service description document, all or part of a WEB client application and/or a WEB server application in the remote device so as to be able to communicate with a WEB service and/or a WEB client of an automation equipment, and communicating between a WEB client application and/or a WEB server application of the remote device and a WEB service and/or a WEB client of the automation equipment on the IP network by means of requests and responses complying with the SOAP protocol. An exemplary embodiment is described in the specification from page 14, line 30 to page 16, line 4 with reference to Figure 6. In this exemplary embodiment, remote device 30 runs a computer program 33 that sends a read request over IP network 50 in order to receive service description document 61. Remote device 30 includes a computer program 33 which develops WEB client application 31 and/or WEB server application 32 from the service description document 61. WEB client application 31 and/or WEB server application 32 communicates with WEB service 21 and/or WEB client 22 of automation equipment 10 on IP network 50 by means of requests and responses complying with the SOAP protocol.

Independent Claim 19 is directed to a communication process including: running a computer application in a remote device, sending from the application a read request on an IP network in order to receive, in a response, a service description document, and communicating between a WEB client application and/or a WEB server application included in the computer application of the remote device and a WEB service and/or a WEB client of automation equipment on the IP network, by means of requests and responses complying

with the SOAP protocol. An exemplary embodiment is described in the specification from page 14, line 30 to page 16, line 4 with reference to Figure 6. In this exemplary embodiment, remote device 30 runs a computer program 33 that sends a read request over IP network 50 in order to receive service description document 61. Remote device 30 includes WEB client application 31 and/or WEB server application 32 which communicate with WEB service 21 and/or WEB client 22 of automation equipment 10 on IP network 50 by means of requests and responses complying with the SOAP protocol.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are:

- (a) whether Claims 1-11 and 13-20 are anticipated under 35 U.S.C. §102(b) by Linderman (U.S. Patent Publication No. 2002/0032790, hereinafter “Linderman”); and
- (b) whether Claim 12 is unpatentable under 35 U.S.C. §103(a) over Linderman in view of ‘Frequently Asked Questions about XML’, (Microsoft, June 2000).

VII. ARGUMENTS

The Examiner’s Answer asserts that the T-box 32 of Linderman is entitled to the benefit of U.S. Provisional Application No. 60/208,045 (P '045) as the T-box 32 of Linderman is allegedly supported by P '045 in compliance with 35 U.S.C. §112, first paragraph. However, it is respectfully submitted that one skilled in the art would not be able to make and use the invention described by Linderman *without undue experimentation*. In accordance with well settled case law, the disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; *mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation*. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d

1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). (Emphasis added.) See also MPEP §2121.01.

The Examiner's Answer ignores the above emphasized requirement, and concludes that the general discussion of the product DaberNet would allow one skilled in the art to make and use the invention described by Linderman. As noted in the Appeal Brief, the two and one half page vague description of P '045 would not allow one skilled in the art to make and use the invention described by Linderman *without undue experimentation*. It is respectfully submitted the mere naming of proposed functions of a proposed product "DaberNet" in P '045 does not enable the detailed description of T-box 32 of Linderman used in the outstanding rejection.

Further, for a proper anticipation rejection, "The identical invention must be *shown in as complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (Emphasis added). See also MPEP §2131. The vague description of DaberNet in P '045 does not support or show an apparatus or method in as *complete detail* as recited in any of independent Claims 1, 18, or 19.

In fact, the failure of the outstanding rejection to meet this requirement is especially evident with respect to Claims 15, 18, and 19. The Examiner's Answer asserted that the statement of P '045 that "the DaberNet package will scale to include server configuration, and configuration of other network devices with specifications for network controllability" enables a disclosure that anticipates the service description document as recited in Claims 15, 18, and 19. However, it is respectfully submitted that this vague description merely naming the hoped for functions of a prospective product does not support or show the apparatus or method in as *complete detail* as recited in any of Claims 15, 18, or 19.

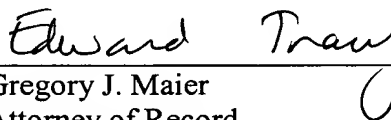
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Consequently, independent Claims 1, 18, and 19 are believed to define over
Linderman for at least the reasons discussed herein and in the Appeal Brief.

It is respectfully requested that the outstanding rejections be REVERSED.

Respectfully submitted,

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